REMARKS

Claim 1-13 are pending. All claims are under examination.

The above-identified application is assigned to Shin-Etsu Chemical Co., Ltd. of Tokyo, Japan, (SHIN-ETSU) by virtue of an assignment recorded among the records of the United States Patent and Trademark Office on reel 014565 at frame 0104.

Publication Number 2003/0139481 A1 (Osawa), is assigned on its face to SHIN-ETSU.

The subject matter of Publication Number 2003/0139481 A1 and the present invention claimed in the above-identified application were, at the time the invention was made, subject to an obligation of assignment to SHIN-ETSU.

The attention of the Examiner is invited to 35 USC 103(c) and to MPEP 706.02(l) a copy of which is attached hereto as Exhibit A.

Osawa is prior art, if at all, only under the provisions of 35 USC 102(e) as argued by the Examiner in paragraph 3 on page 2 of the last Office Action. Since Osawa is subject to the special conditions set forth in 35 USC 103(c), Osawa "shall not preclude patentability" as provided for in 35 USC 103(c).

Since Osawa is not prior art, the rejection in paragraph 3 of claims 1-8 and 13 over US patent 6,077,966 (Matsumura) in view of Osawa is no longer valid.

There is no pending rejection on any ground based on Matsumura alone. There are no other grounds of rejection. In view of this, the Examiner is respectfully requested to pass the case to issue.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact David R. Murphy (Reg. No. 22,751) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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GMM/DRM:trb
0171-1018P

Attachment: Exhibit A

(Rev. 02/12/2004)

EXAMINATION OF CONTINUING APPLICATION COMMONLY OWNED WITH ABANDONED PARENT APPLICATION TO WHICH BENEFIT IS CLAIMED UNDER 35 U.S.C. 120

An application claiming the benefit of a prior filed copending national or international application under 35 U.S.C. 120 must name as an inventor at least one inventor named in the prior filed application. The prior filed application must also disclose the named inventor's invention claimed in at least one claim of the later filed application in the manner provided by the first paragraph of 35 U.S.C. 112. This practice contrasts with the practice in effect prior to November 8, 1984 (the date of enactment of Public Law 98-622) where the inventorship entity in each of the applications was required to be the same for benefit under 35 U.S.C. 120.

So long as the applications have at least one inventor in common and the other requirements are met, the Office will permit a claim for 35 U.S.C. 120 benefit without any additional submissions or notifications from applicants regarding inventorship differences.

In addition to the normal examination conducted by the examiner, he or she must examine the earlier filed application to determine if the earlier and later applications have at least one inventor in common and that the other 35 U.S.C. 120 requirements are met. The claim for 35 U.S.C. 120 benefit will be permitted without examination of the earlier application for disclosure and support of at least one claim of the later filed application under 35 U.S.C. 112, first paragraph unless it becomes necessary to do so, for example, because of an intervening reference.

706.02(l) Rejections Under 35 U.S.C. 102(f)/103 and 35 U.S.C. 102(g)/103; 35 U.S.C. 103(c) [R-2]

35 U.S.C. 103. Conditions for patentability; non-obvious subject matter.

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(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Prior to November 29, 1999, 35 U.S.C. 103(c) provided that subject matter developed by another which qualifies as "prior art" only under subsections 35 U.S.C. 102(f) or 35 U.S.C. 102(g) is not to be considered when determining whether an invention sought to be patented is obvious under 35 U.S.C. 103, provided the subject matter and the claimed invention were commonly owned at the time the invention was made. See MPEP § 706.02(l)(1) for information regarding when prior art under 35 U.S.C. 102(e)/103 is disqualified under 35 U.S.C. 103(c).

For applications filed prior to November 29, 1999, the subject matter that is disqualified as prior art under 35 U.S.C. 103(c) is strictly limited to subject matter that A) qualifies as prior art only under 35 U.S.C. 102(f) or 35 U.S.C. 102(g), and B) was commonly owned with the claimed invention at the time the invention was made. If the subject matter that qualifies as prior art only under 35 U.S.C. 102(f) or 35 U.S.C. 102(g) was not commonly owned at the time of the invention, the subject matter is not disqualified as prior art under 35 U.S.C. 103(c). See *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1403-04, 43 USPQ2d 1641, 1646 (Fed. Cir. 1997) ("We therefore hold that subject matter derived from another not only is itself unpatentable to the party who derived it under § 102(f), but, when combined with other prior art, may make a resulting obvious invention unpatentable to that party under a combination of §§ 102(f) and 103.") If the subject matter qualifies as prior art under any other subsection (e.g., subsection 35 U.S.C. 102(a), 35 U.S.C. 102(b), or 35 U.S.C. 102(e)) it will not be disqualified as prior art under 35 U.S.C. 103(c).

It is important to recognize that 35 U.S.C. 103(c) applies only to consideration of prior art for purposes of obviousness under 35 U.S.C. 103. It does not apply to or affect subject matter which is ...ed in a rejection< under 35 U.S... ...plicant urging that subject m... ... burden of establishing tha... ...t the time the claimed invent... ...nt proper evidence of common ow... ...the time the later invention was made, the appropriate rejection under 35 U.S.C. 102(f) or 35 U.S.C. 102(g) as it applies through 35 U.S.C. 103 should be made. See MPEP